

REMARKS

Reconsideration of the subject application in view of the present amendment is respectfully requested.

With the present amendment claims 1 has been canceled. Claim 19 has been added. Claims 2, 4, 10, 15, and 18 have been amended to provide their proper dependency.

Based on the foregoing amendments and the following remarks the application is deemed to be in condition for allowance and action to that end is respectfully requested.

I. Rejection Under 35 U.S.C. § 112

The Examiner rejected claims 1-18 under 35 U.S.C. § 112, second paragraph, for allegedly being indefinite, pointing out specific language in claim 1 rendering this claim and claims dependent thereon indefinite. As noted above, claim 1 has been canceled.

It is respectfully submitted that claim 19 and claims 2-18 dependent on claim 19, directly or indirectly comply with all of the requirements of 35 U.S.C. §112.

II. Rejection Under 35 U.S.C. § 112

The Examiner rejected Claim 1 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 307,252 (Armstrong). Claims 1 and 4-6 were rejected as anticipated by U.S. Patent No. 2,704,003 (Stevens). Claims 1, 10 and 11 were rejected as being anticipated by Beaver, U.S. Patent No. 1,623,379 (Beaver). Claims 2-3 were rejected as being obvious over Armstrong in view of Folz, U.S. Patent No. 6,458,022.

It is respectfully submitted that claims 2-19 are patentable over the cited references. Specifically, claim 19 recites a device securable on a screw-driving power tool for holding and supporting a fastening element insertable in a tool bit of the power tool. None of Armstrong, Stevens, and Beaver discloses such a device.

Armstrong discloses a bit holder for holding a tool-shank. The bit holder designed to firmly hold a tool during operation and not release it upon start of a drive-in process. It is noted that Armstrong contemplates using the bit holder as a holding chuck in a lathe (page2, lines 15-17). One of ordinary skill in the art would not consider using the Armstrong bit holder for holding and supporting a fastening element.

Both Stevens and Beaver disclose a manually operated wrench. Again, one of ordinary skill in the art would not consider using the wrench of Stevens or Beaver for supporting a fastening element received in a tool bit of a screw-driving power tool.

It is respectfully submitted that the preamble of claim 19 alone distinguishes the present invention defined by claim 19 over the prior art.

It is a long held view that the preamble is given the effect of a limitation, is deemed essential to point out the invention defined by a claim, and is “considered necessary to give life, meaning and vitality to the claims” when “there inhered in the article specified in the preamble a problem, when transcended to that before prior artisan ...” Kopra v. Robie and Maheman, 88 U.S.P.Q. 478, 481 (CCPA 1951). The same court further stated “The nature of the problem characterized the elements comprising the article, and recited in the body of the claim ... so as to distinguish the claim over the prior art.”

The object of the present invention is an improved holding device for holding and supporting a screw at least in the initial phase of the drive-in process with subsequent automatic release of the screw at the end of the screw drive-in process. It is unclear how the above-discussed references which do not

even remotely suggest automatic release of the held object can contribute to achieving the object of the present invention.

Furthermore, claim 19 recites that the clamping members are displaceable, upon application of a force thereto in a direction opposite a drive-in direction of the power tool from a support position into a release position thereof. None of the clamping jaws of any of Armstrong, Stevens and Beaver is released upon application on axial force thereto.

Still further, none of Armstrong, Stevens, and Beaver discloses jaws having a contact region which forms a frontmost stop of the holding device in the drive-in direction of the power tool for engaging a workpiece the fastening element is driven into.

In view of the above it is respectfully submitted that none of Armstrong, Stevens, and Beaver anticipates or makes obvious the present invention, as defined by claims 19, and that claims 19 is patentable over said references.

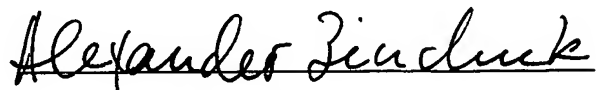
Claims 2-18 depend on claim 19 and are allowable for the same reasons claim 19 is allowable and further because of specific features recited therein which, when taken alone and/or in combination with those of claim 19, are not disclosed or suggested in the prior art.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place the case in condition for final allowance, it is respectfully requested that such amendment or correction be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully submitted,



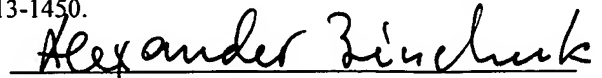
Alexander Zinchuk
Reg. No. 30,541

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Abelman, Frayne & Schwab
666 Third Avenue, 10th Floor
New York, NY 10017-5621

212-885-9383

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Alexander Zinchuk